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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIRK P. BUMGARNER, KENNETH W. ROBERTS,
and DAVID A. TUCKER

Appeal 2009-003422
Application 10/800,551
Technology Center 3600

Before JENNIFER D. BAHR, MICHAEL W. O'NEILL, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL¹

STATEMENT OF THE CASE

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Kirk P. Bumgarner et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 38-49 under 35 U.S.C. § 103(a) as obvious over Bacon (US 6,027,062, issued Feb. 22, 2000) in view of Isoard (US 4,206,883, issued Jun. 10, 1980). We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

The claims on appeal relate to a process for automatically threading an optical fiber through a component in an optical fiber draw, optical fiber winding, or optical fiber testing process.

Claim 38, reproduced below, is illustrative of the subject matter on appeal.

38. A method of threading a moving length of optical fiber through a component in an optical fiber draw, optical fiber winding or optical fiber testing process, comprising:
activating an aspirator to obtain said optical fiber at a first location and moving said aspirator in at least two dimensions to move said optical fiber to a second location to thread said optical fiber through a component in said optical fiber draw process.

The Rejection

The Examiner finds that "Isoard teaches activating an aspirator 13 mounted on a carriage 17, to obtain the fiber at a first location 3, 4 (position I) and moving the fiber to a second location (position II) to thread the fiber through component 7, 8 in the fiber draw process (Fig. 3, col. 4 line 58 to col. 5 line 28)." Ans. 3. Based on this finding, the Examiner concludes that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the positioning device of Bacon to include an aspirator to hold the fiber as suggested by Isoard, to hold the fiber while transferring and the fiber without causing damage to the fiber." Ans. 4.

Contentions

Appellants contend, *inter alia*, “Isoard clearly does not move aspirator 13 from a first location 3, 4 to a second location to thread the fiber (yarn) through either of components 7 or 8.” Br. 5. Appellants explain that based on the Examiner’s findings Isoard’s aspirator 13 is essentially equivalent to Bacon’s aspirator 80 and as such the Examiner’s proposed modification does not position a fiber through a component; instead, both aspirators 13 and 80 draw fibers. Appellants urge that even if Bacon and Isoard were combined as proposed by the Examiner, the combination would not result in Appellants claimed invention. Appellants’ submit that there is no teaching, in any of the references, which would provide support for the Examiner’s reasoning that the aspirator would cause less damage to optical fiber than Bacon’s disclosed positioning device.

OPINION

Issue

The determinative issue in this appeal is:

Did the Examiner err in articulating the scope and content of Isoard or in explaining how Isoard’s teachings, when properly understood, would be utilized to render obvious the claimed process set forth in claim 38 when Isoard’s teachings were combine with Bacon’s optical fiber winder?

Analysis

After our review of Isoard, we agree with Appellants that Isoard does not move the aspirator 13 from a first location to a second location in order

to thread fibers through components 7 or 8 as the Examiner appears to have found. The Examiner has either erred in articulating the scope and content of Isoard or in explaining how Isoard's teachings would be utilized with Bacon's optical fiber winder to render obvious the claimed process set forth in claim 38.

The Examiner relies on column 4, line 58 through column 5, line 28 of Isoard to support the Examiner's findings within the Answer on page 3. This section of Isoard teaches the construction of the second spinning installation embodiment. In this embodiment, aspirator 13 (nozzle, Isoard's nomenclature) is mounted on the slide rail 11 by way of carriage 17. Aspirator 13 is removably attached to carriage 17 such that it can be used as a handling gun for positioning the yarns around drawing units 3 and 4. Then, aspirator 13 is fixed to the carriage 17 for the transfer operation. The transfer of yarns is caused by descending the aspirator 13 from position I to position II, whilst the yarns continue to be drawn off and removed by aspirator 13. Isoard then teaches that the positioning of each yarn on its wind-up spindle 7 or 8 is effected by means of the catching nozzle 16 (aspirator, Appellants' nomenclature), as in the preceding case. The preceding case is how the catching nozzle 16, in conjunction with an operator, anchors the yarns to their respective spindles within the first embodiment. In the first embodiment, catching nozzle 16, which is handled by an operator, seizes each yarn individually in order to anchor the yarn to their respective spindle. Isoard, col. 4, ll. 29-35.

As such, the Examiner's finding that the Isoard's aspirator 13 obtains fiber at a first location 3, 4 and moves the fiber to a second location in order to thread the fiber through a component 7 or 8 is based on an erroneous or

incomplete understanding of Isoard's teachings of the second embodiment. Moreover, the Examiner has failed to cogently explain how a proper understanding of Isoard's teachings, i.e., the catching nozzle 16 that is utilized by the operator to seize each yarn and anchor each yarn to its respective spindle can be applied to Bacon's optical fiber winder to render obvious the claimed process set forth in claim 38.

Moreover, the Examiner's reasoning for combining the teachings of Isoard's second embodiment to Bacon's optical fiber winder lacks evidence in the record to lay a foundation that some rational underpinning exists other than hindsight gleaned from Appellants' Specification. The Examiner appears to have reasoned that a person of ordinary skill in the art would apply the teachings of Isoard to Bacon in order to hold the fiber while transferring and without causing damage to the fiber. *See* Ans. 4. As such, it appears the Examiner has given two reasons for making the combination: (1) to hold the fiber and (2) without causing damage. Without more evidence or analysis on the Examiner's part as to why a person of ordinary skill in the art would want to replace the Bacon's mechanical positioning device with an aspirator mechanism as taught is Isoard, the rejection is essentially utilizing the claimed invention as a template to reconstruct it from the prior art. The Examiner's other reasoning that a person would replace the mechanical position device with an aspirator because the aspirator causes less damage to the optical fiber has no basis in fact within the record. Moreover, that reasoning has been challenged by Appellants in the form of a declaration that declares neither the Bacon nor the claimed invention result in any damage occurring to the fiber. Bumgarner Declaration, ¶ 5. As such, evaluating all the evidence in the record it

appears that the Examiner is creating a problem of damage in order to solve the problem instead of the prior art reference having a problem and another prior art reference teaching how to solve the problem.

Therefore, we are constrained to reverse the rejection of claim 38. Likewise, we are constrained to reverse the rejection of claims 39-49, which depend from claim 38.

CONCLUSION

The Examiner erred in not properly articulating the scope and content of Isoard and in not explaining how Isoard's teachings, when properly understood, would be utilized to render obvious the claimed process set forth in claim 38 when Isoard's teachings were combine with Bacon's optical fiber winder.

DECISION

In view of the foregoing, the Examiner's decision to reject claims 38-49 as obvious over Bacon in view of Isoard is reversed.

REVERSED

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